Remarks

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing Amendment to the Claims, claims 1-30 are pending in the application, of which claims 1, 8, 14, 23, and 27 are independent. By the foregoing Amendment, claims 1, 8, 14, 23, 24, and 27 are sought to be amended. No new matter is embraced by this amendment and its entry is respectfully requested. Based on the above Amendment and the remarks set forth below, it is respectfully requested that the Examiner reconsider and withdraw all outstanding rejections.

Rejection under 35 U.S.C. § 102

The Examiner, on page 2 of the Office Action, has rejected claims 1, 3, 6-8, 12-14, 17, 18-23 and 27-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,652,412 to Lazzouni *et al.* (hereinafter "Lazzouni"). Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

To anticipate a claim of a pending application, a single reference must disclose each and every element of the claimed invention. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1397 (Fed. Cir. 1986). The exclusion of a claimed element from the single source is enough to negate anticipation by that reference. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984).

With regards to independent claim 1, Lazzouni does not teach or suggest every element of Applicants' claimed invention. For example, Lazzouni does not teach or suggest at least the claimed element of:

a processor coupled to the memory storage unit, the processor to receive data associated with a handwritten notation applied to a printed page and an electronic image of an area of the printed page near the notation, the electronic image including a printed passage comprising text, illustrations, or both the text and the illustrations, the processor to use the printed passage to identify a corresponding passage in the electronic version of the page stored in the memory storage unit, to use the data associated with the handwritten notation to create an electronic notation, and to incorporate the electronic notation in the electronic version of the page stored in the memory storage unit as a comment linked to the corresponding passage.

Unlike the present invention, Lazzouni does not teach or suggest "the processor to receive data associated with a handwritten notation applied to a printed page and an electronic image of an area of the printed page near the notation, the electronic image including a printed passage comprising text, an illustration, or both the text and the illustration, the processor to use the printed passage to identify a corresponding passage in the electronic version of the page stored in the memory storage unit, to use the data associated with the handwritten notation to create an electronic notation, and to incorporate the electronic notation in the electronic version of the page stored in the memory storage unit as a comment linked to the corresponding passage." To the contrary, Lazzouni teaches a pen that makes visible markings on encoded paper, wherein the encoded portion of the paper is not visible. *Lazzouni*, col. 4, lines 7-14 and 52-53. The visible markings are traced by the tip of the pen and "[s]imultaneously, the absolute position of the tip of the pen on the surface of the paper is determined by optically reading a pattern of prerecorded pixels associated with the surface of the paper." *Id.* at lines 56-62. The position information is provided to the recording unit, where it is stored for later use. *Id.* at lines 62-63. Thus, unlike the present invention were the processor receives data associated with a handwritten notation applied to a printed page and an

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electronic image of an area of the printed page near the notation, the electronic image including a printed passage comprising text, illustrations, or both the text and the illustrations, Lazzouni teaches that the recording unit receives the position information and stores it for later use.

Also, unlike the present invention, Lazzouni does not teach or suggest "to use the data associated with the handwritten notation to create an electronic notation, and to incorporate the electronic notation in the electronic version of the page stored in the memory storage unit as a comment linked to the corresponding passage." In fact, Lazzouni does not teach or suggest an electronic version of the page stored in the memory storage unit.

With respect to Applicants' independent claim 8, Lazzouni does not teach or suggest at least the following elements:

> a writing utensil to apply a notation to the printed page, the writing utensil including a scanner positioned to scan a surface of the printed page as the notation is being applied to the printed page, the surface of the printed page including visible printed matter corresponding to a part of the electronic version of the printed page;
> wherein the processor includes a port to receive from the writing utensil stroke data associated with the notation applied by the writing utensil and an electronic image of the visible printed matter of an area of the surface of the printed page near the applied notation scanned by the scanner, and is configured to create an electronic notation based on the stroke data and to incorporate the electronic notation into the electronic version of the printed page as a comment linked to the corresponding part of the electronic version of the printed page.

As previously indicated, Lazzouni does not teach or suggest that the surface of the printed page includes visible printed matter corresponding to a part of the electronic version of the printed page. Instead, as indicated above, Lazzouni teaches that the encoded paper has a prerecorded pattern of pixels (not visible to the human eye) which

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contain encoded position information to permit the absolute position of the pen tip to be determined simultaneously with writing.   Lazzouni, col. 4, lines 10-14, lines 56-62; col. 6, lines 35-39.

Lazzouni also does not teach "wherein the processor includes a port to receive from the writing utensil stroke data associated with the notation applied by the writing utensil and an electronic image of the visible printed matter of an area of the surface of the printed page near the applied notation scanned by the scanner, and is configured to create an electronic notation based on the stroke data and to incorporate the electronic notation into the electronic version of the printed page as a comment linked to the corresponding part of the electronic version of the printed page" As indicated above, Lazzouni teaches obtaining position information, not an electronic image of an area of the printed page that includes visible printed matter. Lazzouni also does not teach or suggest "to create an electronic notation based on the stroke data and to incorporate the electronic notation into the electronic version of the printed page as a comment linked to the corresponding part of the electronic version of the printed page. In fact, Lazzouni does not teach or suggest having an electronic version of the printed page.

With respect to independent claim 14, Lazzouni does not teach or suggest at least the following elements:

> applying a handwritten notation with a writing utensil to a page that includes a visible printed passage with which the handwritten notation is associated;
> simultaneously capturing stroke data associated with the handwritten notation and scanning a portion of the associated printed passage with a scanner connected to the writing utensil to create a scanned image; and
> correlating the captured stroke data with a particular portion of an electronic version of the page based on the scanned image.

For at least the same reasons indicated above, Lazzouni does not teach "... a page that includes a visible printed passage ...", "scanning a portion of the associated printed passage ... to create a scanned image", or "correlating the captured stroke data with a particular portion of an electronic version of the page based on the scanned image."

With respect to independent claim 23, Lazzouni does not teach at least the following elements of:

> create an electronic notation in response to received data associated with a handwritten notation applied to a printed version of a page and a received electronic image of a passage identifier indicative of a visible printed passage on the page; and
> incorporate the electronic notation into an electronic version of the page stored in memory as a comment linked to a passage in the electronic version of the page, wherein the passage in the electronic version of the page corresponds to the received electronic image of the passage identifier.

As indicated above, Lazzouni does not teach "a passage identifier indicative of a printed passage" and therefore cannot teach "a received electronic image of a passage identifier indicative of a printed passage on the page" or "incorporate[ing] the electronic notation into an electronic version of the page stored in memory as a comment linked to a passage in the electronic version of the page, wherein the passage in the electronic version of the page corresponds to the received electronic image of the passage identifier." In fact, as previously indicated, Lazzouni does not teach or suggest an electronic version of the page.

With respect to independent claim 27, Lazzouni does not teach or suggest at least the following elements:

> a writing utensil having a writing tip to selectively dispense a writing medium onto a printed page for creating a notation and to capture

> stroke data associated with the notation, the writing utensil including a
> scanner positioned immediately above and outward from the writing tip to
> scan an area of the printed page near the notation as the notation is being
> applied to create an image, the scanned area including a printed passage,
> the printed passage visible to a user of the writing utensil; and
> a processor coupled to the writing utensil to identify a correlation
> between the stroke data and the image.

As indicated above, Lazzouni does not teach a visible printed passage on the printed
page, and therefore cannot teach "to scan an area of the printed page near the notation as
the notation is being applied to create an image, the scanned area including a visible
printed passage" or "a processor ... to identify a correlation between the stroke data and
the image."

Thus, for at least the foregoing reasons, Applicants respectfully submit that
independent claims 1, 8, 14, 23, and 27, and the claims that depend therefrom (claims 2-
7, 9-13, 24-26, and 28-30, respectively) are not anticipated by Lazzouni. Applicants
respectfully request that the Examiner reconsider and withdraw the rejection of
independent claims 1, 8, 14, 23, and 27, and the claims that depend therefrom,
respectively.

Rejection under 35 U.S.C. § 103

The Examiner, on page 9 of the Office Action, has rejected claims 2, 4, 5, 9-11,
15, 16, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No.
5,652,412 to Lazzouni in view of U.S. Patent No. 6,050,490 to Leichner *et al.*
(hereinafter "Leichner"). Applicants respectfully disagree. Based on the remarks set

forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Claims 2, 4, 5, 9-11, 15, 16, and 24-26 depend from independent claims 1, 8, 14, and 23, respectively, and are patentable over Lazzouni for at least the reasons stated above. Furthermore, Leichner does not teach or suggest the features missing from Lazzouni. In fact, Leichner teaches away from Applicants invention by placing the pen tip and scanner at the opposite ends of the pen to prevent a user from simultaneously scanning while obtaining position data. *Leichner*, col. 4, line 65 – col. 5, line 10. Furthermore, Leichner teaches that "using the identification code, optical character recognition can be employed to automatically process data actually written upon a page 14 or 20 *without the requirement of scanning fields on the preprinted page or form ....*" *Leichner*, col. 4, lines 43-49. Thus, with Leichner there is no need to simultaneously scan an area of page while obtaining position data for the handwritten notation. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of dependent claims 2, 4, 5, 9-11, 15, 16, and 24-26.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all currently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,

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/Crystal D. Sayles, Reg. No. 44,318/

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